

**REMARKS**

Claims 1, 12, 16, 17, 19, 20, 28 and 41 are amended as discussed below. No new subject matter is introduced by the present amendments. Claims 1, 2, 4-7, 9-20, 28, 29, 31-34, and 36-42 are pending in the present case.

Claim Rejections – 35 U.S.C. 112

Claims 1, 2, 4-7, 9-20, 28-29, 31-34, and 36-41 are rejected under 35 U.S.C. 112 first and second paragraph as containing subject matter which was not described in the specification. More particularly, it is alleged that the expression "said assessment comprising a grade for the vehicular part" found in claims 1, 28 and 41 has no support in the specification.

The reason for supporting the foregoing argument is found at page 2 of the Final Office Action and is based on a passage of the specification (paragraph [0034]) which states "...the folder is then returned to the dealer along with the assessment or grading..." The Final Office Action then states that "the grade and the assessment are equivalent". The applicant respectfully disagrees for at least two reasons.

First, had the Applicant wanted the terms grade and assessment to be interpreted as equivalent, he would have put the terms "or grade" between parenthesis, brackets or commas. It was and is still the Applicant's intention to have both terms not interpreted as equivalents. The Applicant should be afforded the interpretation of the term "or" as an alternative between to elements not the equivalent between to elements.

Second, the difference between "grade" and "assessment" is present in the following passages taken from the specification:

- Paragraph [0002]: "Currently there exists no system that allows reducing processing costs by evaluating **and** grading parts before they leave the dealership". (emphasis added) A person skilled in the art would understand that evaluating is used here in the same sense as assessing. Note that the term "and" and not "or" is used here to identify the difference between both terms.
- Paragraph [0037]: "(...), which displays the electronic folder for each

assessed part, including the grading, list of missing parts and original images." Again, it is clear from this passage that the grade is not the same as the assessment. In fact, this passage clearly shows that, according to this embodiment (not necessarily all embodiments), the assessment (of the "assessed part") comprises more than the grade. It can also include the list of missing parts and original images. **This identifies the grade, the list of missing parts and original images as a subset of the assessment.**

In light of the above arguments, it is clear that the term "grade" and "assessment" are not the same, as fully supported by the description. For these reasons, it is submitted that claims 1, 2, 4-7, 9-20, 28-29, 31-34, and 36-41 are allowable. Reconsideration is kindly requested.

#### Claim Rejections – 35 U.S.C. 101

Claims 1, 2, 4-7, 9-20, and 38-41 are rejected for not tying the method steps to another statutory class, or positively reciting the subject matter that is being transformed, or material that is being changed in state.

Claims 1 and 41 are hereby amended to further recite transformed subject matter, e.g., "modifying, at a terminal at said assessment center, the electronic folder".

In light of this amendment, it is submitted that claims 1, 2, 4-7, 9-20, and 38-41 are allowable. Reconsideration is kindly requested.

#### Claim Rejections – 35 U.S.C. 102

Claims 28, 29, 31, 32 and 36 are rejected as being anticipated by Joao (US2002/00116655A1). The Applicant's response is detailed below.

Regarding claim 28, the Applicant submits the following remarks:

Joao never discloses an assessment comprising a grade for a vehicular part. For this reason alone, the foregoing claims should overcome the 102 rejection.

Furthermore, the Final Office Action states that Joao discloses at paragraph [293] that "the user [is] sent the report or assessment". The report to which this refers was

generated by the "central processing computer 10" in Joao. See paragraph [289] in Joao which states: "At step 206, the central processing computer 10 will generate a repair, maintenance, and/or servicing, report which will outline and/or prescribe the respective repair, maintenance and/or servicing, procedures for the diagnosis and/or for possible diagnoses, if pertinent." In Joao, it is the "central processing computer 10" which generates the report. In claim 28, the "generation" of the assessment (which is what the Final Office Action considers is equivalent to the report of Joao) is performed at the terminal of the assessment center not at the computer server which is what is stated to be the equivalent to the "central processing computer 10".

In addition, Joao states in paragraph [297]: "At step 216, the dealer, service provider, or the repair facility, can access the central processing computer 10 from its respective computer and transmit data and/or information regarding the repair, maintenance, procedure, and/or servicing, procedure, which has been performed on or for the vehicle, so as to update the vehicle file and/or vehicle maintenance history." Joao discloses that the vehicle file is **updated once the repair** (or other procedure) **"has been performed"**; or in other words, **after a repair (maintenance/procedure) is performed** on the vehicle by the dealer, service provider, or repair facility. The claim language now clearly claims otherwise.

In view of the above, Joao does not disclose (1) "said electronic folder having been modified at said terminal of said assessment center to include said grade of said assessment, prior to a disposition being determined for the vehicular part"; and "said output means for sending said electronic folder, once modified to include said grade, to the vehicular dealer, where the grade will be used to determine the disposition of the vehicular part", as claimed in amended claim 28.

The Applicant therefore respectfully submits that Joao does not teach or suggest the combination of elements described in independent claim 28. The claim rejections under 35 U.S.C 102 to independent claim 28 and those depending from it should be withdrawn at least in view of the above-noted difference.

In view of the above, the Applicant submits that claims 28-29, 31-32 and 36 are allowable. Reconsideration is kindly requested.

Claim Rejections – 35 U.S.C. 103

Claims 1, 2, 4-7 and 9-20, 38 and 41 are rejected as being obvious over Joao in view of Hormozi.

Regarding independent claims 1 and 41, the Applicant submits the following remarks:

In addition to the differences noted above regarding claim 28 and Joao, which is also applicable to claims 1 and 41 since they incorporate similar subject matter, Hormozi does not disclose any "grade" or "assessment". Paragraphs 1 and 2 of page 26 in particular do not discuss "determining a disposition based on a grade" as per claims 1 and 41. The Applicant respectfully requests from the Examiner that the exact passage of Hormozi which discusses "assessment" or "grading" be identified since the Applicant fails to see where Hormozi discloses "determining whether said vehicular part may be recycled based on said **assessment**" (emphasis added) is disclosed. Since none of the prior art disclose such a combination of elements, a person skilled in the art would not arrive at the claimed subject matter from Joao in view of Hormozi.

In view of the above, claims 1 and 41 are allowable, along with dependent claims 2, 4-7, 9-20 and 38. Reconsideration is kindly requested.

Claims 33, 34 and 37 are rejected as being obvious over Joao. Claim 39 is rejected as being obvious over Joao in view of Hormozi and further in view of Williams et al.

In view of the above comments relating to claim 28, the Applicant submits that dependent claims 33, 34, 37 and 39 are also allowable since they incorporate the subject matter of claim 28. Reconsideration is kindly requested.

Claim 40 is rejected as being obvious over Joao in view of Hormozi and further in view of Untiedt et al. Claim 42 is rejected as being obvious over Joao in view of Park et al. These rejections are also moot in view of the arguments and amendments submitted above to independent claim 1 and the claim dependencies.

In view of the above, it is respectfully submitted that claims 1, 2, 4-7, 9-20, 28, 29, 31-34, and 36-42 are allowable. A notice to this effect is earnestly solicited.

Respectfully,

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